I. General Remarks Concerning This Response

Claims 1-11 are currently pending in the present application. No claims have been amended in this response; no claims have been added; and no claims have been canceled. Reconsideration of the claims is respectfully requested.

II. 35 U.S.C. § 103—Obviousness using *Haverstock et al.*

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Sposato, "Method and appartus for remotely booting a client computer from a network by emulating remote boot chips", U.S. Patent Number 6,463,530 B1, filed 06/10/1999 in view of Emens et al., Grossman et al., and/or O'Toole et al..

This rejection is respectfully traversed. **This rejection must be withdrawn** because Sposato does not qualify as prior art against the present application.

All rejections under 35 U.S.C. § 103(a) logically rely on the relationship of the applied prior art to the claimed invention under 35 U.S.C. § 102. In other words, before the prior art can be properly applied against the claimed invention with respect to 35 U.S.C. § 103(a), the prior art must have a specific, statutorily defined relationship to the claimed invention as set forth in one of the subsections of 35 U.S.C. § 102. Some of the subsections of 35 U.S.C. § 102 statutorily deny patentability of a claimed invention if prior art exists that identically discloses the claimed invention. If there is prior art that does not identically disclose the claimed invention, then 35 U.S.C. § 103(a) can be used to prevent patentability if the claimed invention is obvious is view of the prior art. The relationship between 35 U.S.C. § 103(a) and 35 U.S.C. § 102 is stated in the statute:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The pending rejection uses various references in view of Sposato to deny patentability of the present invention under 35 U.S.C. § 103(a) because of an assumption underlying the grounds of rejection that Sposato would qualify as prior art under 35 U.S.C. § 102(e).

However, this assumption is incorrect. An inspection of Sposato reveals that this patent is currently assigned to International Business Machines Corporation (IBM). The subject matter of Sposato was owned by IBM and subject to an obligation of assignment to IBM at the time that the present invention was made. In addition, at that same time, the present invention was owned by IBM and subject to an obligation of assignment to IBM. Hence, the present invention and the subject matter in Sposato were owned by a common assignee, i.e. IBM, at the time that the present invention was made.

The American Inventors Protection Act (AIPA) of 1999 changed 35 U.S.C. § 103(c), which applies to any patent application filed on or after the date of enactment, November 29, 1999.

35 U.S.C. § 103(c) states:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In other words, prior art that would otherwise qualify under 35 U.S.C. § 102(e) cannot be used to deny patentability if the prior

art and the claimed invention were commonly owned or subject to an assignment to a common assignee at the time of the invention.

35 U.S.C. § 103(c) is applicable to the present invention because the present application was filed on 06/28/2001, and

Sposato is disqualified as prior art against the present invention. Since the grounds of the pending rejection can no longer be based on the patent publications of Sposato, the pending grounds of rejection must be withdrawn.

III. Conclusion

It is respectfully urged that the present application is patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

DATE: September 26, 2006

Respectfully submitted,

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